

Application No. 10/706,339

Remarks

Applicants thank the Examiner for his careful consideration of the application.

Election/Restrictions

The Examiner acknowledged Applicant's election of Group 1 drawn to a self-aligning motor mount in the reply filed on January 10, 2006.

The Examiner withdrew claims 15 – 21 from further consideration pursuant to 37 CFR 1.142(b), as being drawing to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 10, 2006.

The Examiner telephoned Applicant's representative that the reply filed on January 10, 2006 was not fully responsive to the Office Action because the applicant was non-responsive in regard to the election of species requirement in the restriction mailed December 27, 2005. Applicant's representative admitted that he had not responded to the species election requirement and made a good faith election of claims corresponding to one embodiment. The Examiner accepted Applicant's selection of claims, and then subsequently decided that none of the claims read on any of the drawings, and much to the surprise of Applicant's representative, the Examiner withdrew claims 1 – 10 and 12 – 14 as being drawn to a non-elected species.

The Examiner should withdraw his withdrawal of the remaining claims in the application because (1) The election of species requirement was improperly made and (2) Figures 1 and 2 disclose a self-aligning motor mount as recited in claims 1 and 7. Applicant addresses each of these points in the following sections. Additionally, Applicant would be willing to amend the claims or the drawings if necessary.

Application No. 10/706,339

The Election of Species Was Improperly Made

The Examiner improperly issued an Election of Species requirement.

Elections, like restrictions, are made between claims and not drawings. Identifying "species" by drawings is common practice. However, election of species is proper between sets of claims not drawings. The Examiner should first make a determination that the claims recite different species, before issuing an election of species requirement. Applicant intended each drawing to show various embodiments of a motor mount. It is not apparent that any claim reads on any single drawing. However, this fact would not preclude patentability of the claims.

Rather than consider all the claims withdrawn (a very surprising first for this Applicant's representative), the Examiner should have issued an objection to the drawings. The Examiner asserts that Figures 1 and 2 do not read on any of the claims. First, the Examiner has not identified support for the argument that all the elements of a claim have to be present in a single drawing. Applicant's representative would like the Examiner to identify any drawing that reads on any of the claim. Second, the Examiner has not established that any drawing includes all of the limitations of any of the claims. If none of the drawings include all of the limitations of any of the claims, and the Examiner insists on maintaining an election of species requirement, than the appropriate Examiner action is to issue an objection to the drawings. There is ample support in the written description to support such amendments to the drawings without introducing any new matter.

Further, claims 1-14 should not be subject to an election of species requirement as searching the subject matter of these claims would not be an undue burden on the Examiner. MPEP § 803 states in pertinent part, "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (emphasis added). The subject matter of claims 1-14 is closely related. Applicant cannot imagine that the Examiner would have to search separate groups/subgroups and the Examiner has not suggested that he would. In fact, the Examiner has suggested quite the opposite. In his original restriction requirement, the

Application No. 10/706,339

requirement, the Examiner asserted that he would search class 74, subclass 74 for claims 1-14. This appears to be an argument that no undue burden exists. Applicant would appreciate it if the Examiner could explain how searching one class and subclass is an undue burden.

Figures 1 and 2 Disclose a Self-Aligning Motor
Mount as Recited in Claims 1 and 7

Regardless of whether the restriction requirement was proper or improper, the limitations recited in claims 1 and 8 are shown in Figures 1 and 2.

In claim 1, Applicant recites a self-aligning motor mount that includes a mounting bracket that can be attached to a machine frame, a locator ring that can be attached to a drive motor front bearing hub and in alignment with a drive pinion gear center line, the locator ring further being set to a predetermined angle for locating the drive pinion gear with a driven gear to achieve correct backlash, a section of the locator ring including a slot on a pinion centerline arc that can engage a necked down shaft extension of the shaft on which the driven gear is mounted, a pin in the locator ring, opposite the slot, that ensures that the motor is in the correct position on the mounting bracket, and an opening in the mounting bracket into which the pin drops when the motor and assembly bracket are coupled, prior to assembly on a machine back plane, thus preventing the motor from rotating 360 degrees and keeping the locator opening on a correct side of the shaft extension.

The Examiner asserts that figures 1 and 2 do not show a drive pinion gear with a driven gear, or a necked down shaft extension. However, Applicant never claimed either of these features. Claim 1 does recite a locator ring *in alignment with a drive pinion gear centerline*, and that the locator ring is set to an angle *for locating a drive pinion gear with a driven gear*, but does not in any way claim either a drive pinion gear or a driven gear. Claim 1 also recites that a section of the locator ring includes a slot on a pinion centerline arc *that can engage a necked down shaft extension*, but never claims a necked down shaft extension. These clauses simply characterize the locator ring and do not add any new limitations.

Application No. 10/706,339

limitations. Therefore, Figures 1 and 2 read on claim 1 as drafted.

In claim 8, Applicant recites in a device including a driving gear mounted on a drive shaft selectively driven by a motor and a driven shaft including a shaft extension and on which a driven gear is mounted, a self-aligning motor mount. The self-aligning motor mount includes a locator ring coaxially arranged about the drive shaft, a motor mounting bracket including an aperture through which the drive shaft and the guide ring extend, a first ear projecting from an outer circumference of the guide ring, a slot on the first ear arranged to interact with the driven shaft, a second ear projecting from the outer circumference of the guide ring, and a pin that, when the motor is rotated from an initial position in a first direction, positively affixes the motor in a particular position relative to the motor mounting bracket.

The Examiner asserts that figures 1 and 2 do not show a drive gear or a driven shaft including a shaft extension. However, Applicant never claimed either of these features. Claim 1 does recite *in a device including* a driving gear mounted on a drive shaft selectively driven by a motor and a driven shaft including a shaft extension and on which a driven gear is mounted, a *self-aligning motor mount comprising....*" It is clear that the claim limitations are directed to the motor mount and not the other aspects of the device. Therefore, figures 1 and 2 read on claim 8.

Therefore, the Examiner has failed to provide adequate reason why claims 1 and 8 are not represented by Figures 1 and 2. **More Importantly and more relevantly, the Examiner has failed to establish that claims 1 and 8 are different species.**

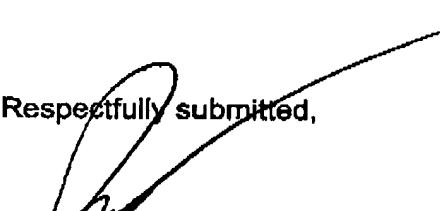
Conclusion

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Application No. 10/706,339

A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,


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JMY/rjc